

REMARKS***Pending claims***

Claims 39 and 41 have been canceled without prejudice to filing a continuation application containing the same. Claims 64- have been added through this Amendment. Claims 1, 5, and 13 have been amended to more clearly point out and distinctly claim the invention. These amendments do not contain new matter and are fully supported by the specification. Support for the phrases "printing pixels of less than 150 microns in diameter on a surface of the contact lens" and "wherein the ink jet printer spaces the pixels less than 80 microns from each other" can be found on page 9, the second complete paragraph. After these amendments are entered, forty one (41) Claims (claims 1-16, and 50-74) are pending.

Claim Objections

Objections of claims 4, 6, 8, and 54 have been overcome by the amendments of those claims.

Rejection of Claims under 35 USC §102

Claims 39 and 41 were rejected under 35 USC 102(e) as being anticipated by Doshi patent number 6,315,410. The rejection over those claim is moot in view of the cancellation of those claims through this Amendment.

Rejection of Claims under 35 USC §103

Claims 1-12, 15-16, 50-56 and 58 were rejected under 35 USC 103(a) as being unpatentable over Doshi in view of Morgan et al. This rejection is respectfully traversed for the following reasons.

Applicants' invention is not obvious in light of the primary reference (Doshi) and (Morgan et al.) because the references combined do not meet all the limitations of the invention. As stated in the MPEP at 706.02(j), to establish a prima facie case of obviousness the "prior art reference (or references combined) must teach or suggest all the claim limitations." As the Examiner noted, Doshi discloses a method of making a colored contact lens comprising printing using an ink jet printer which dispenses droplets onto the surface of a contact lens. Doshi teaches that droplets are between 1 nanoliter and 10 microliters. However, the range of the droplet size specified by Doshi does not overlap with the limitation of the present invention, i.e., less than 100 picoliters. Moreover, Doshi does not disclose nor suggest anything about printing pixels of less than 150 microns in diameter on a surface of the contact lens by, under control of a computer, dispensing droplets of a first colorant from one or more nozzles, onto the surface of the contact lens to form a first pattern,

wherein the ink jet printer spaces the pixels less than 80 microns from each other. On the other hand, neither does the secondary reference (Morgan et al.). The secondary reference discloses ink droplets of less than 70 picoliters in size, but does not disclose nor suggest anything about printing pixels of less than 150 microns in diameter on a surface of the contact lens by, under control of a computer, dispensing droplets of a first colorant from one or more nozzles, onto the surface of the contact lens to form a first pattern, wherein the ink jet printer spaces the pixels less than 80 microns from each other. Thus, neither of the references cited teaches printing on a surface of a contact lens, pixels which are less than 150 microns in diameter and are spaced from each other less than 80 microns. The references combined do not teach all the limitations of the present invention as currently claimed, and as such, the Examiner's rejection over claims 1-12, 15-16, 50-56 and 58 is respectfully traversed.

In addition, regarding claim 2, Applicants respectfully disagree with the Examiner that the nozzles of Doshi will inherently face perpendicular to the surface and in a hemisphere around the lens. Commercially available ink jet printers generally are not used to print an image on a ***flat surface*** and do not have the configuration of nozzle arrangement of the present invention. In contrast, a contact lens has a ***curved surface***, i.e., a hemisphere surface. For such type of articles with curved surface, it would be advantageous to have the configuration of nozzle arrangement of the present invention, since the distances between each nozzle head and the lens surface can be substantially constant and there are minimal variations in the shape and size of dots (pixels) formed on the surface of a contact lens. Therefore, Doshi does not disclose nor suggest anything about the nozzles being facing perpendicular to the surface of the contact lens to be printed and form a hemisphere around the contact lens. Moreover, inherency is a 35 USC 102 doctrine, not a method of analysis which is used in the determination of obviousness. Applicants believe that no printer has been made to have the configuration of nozzle arrangement specified in the claim 2, so no known ink jet printer could inherently have such configuration claimed by the present invention except the present invention.

CONCLUSION

For the foregoing reasons, Applicants submit that Claims 1-16 and 50-74 are patentable over the cited prior arts. Applicant respectfully requests reconsideration and withdrawal of the claim rejections set-forth in the Office Action and allowance of claims 1-16 and 50-74.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,



Jian S. Zhou
Reg. No. 41,422
(678) 415-4691

Date: Jan. 15, 2004

CIBA Vision
Patent Department
11460 Johns Creek Parkway
Duluth, GA 30097